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G. Victor Guyan

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ACCENTURE CHICAGO 28164
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610

EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/667,637	Applicant(s) GUYAN ET AL.	
	Examiner Vanel Frenel	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 13-22 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11, 13-22, 24-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Appeal Brief filed on 1/4/07. Claims 2-11, 13-22 and 24-33 are pending.

2. In view of the Appeal Brief filed on 1/4/07, PROSECUTION IS HEREBY REOPENED as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 C.F.R 1.111 (if this Office action is non-final) or a reply under C.F.R 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplement appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193) (b) (2).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 15 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation of "the payment of a line item".

Claim 15 recites the limitation of "the payment of a line item".

Claim 26 recites the limitation of "the selection of a payment type". Examiner would like a clear definition as to what kind of "the payment of a line item" and "the selection of a payment type" Applicant is referring to. There are insufficient antecedent basis for these limitations in the claims. Appropriate correction is needed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-11, 13-22 and 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al (6,343,271) in view of Borghesi et al (5,950,169).

(A) As per claim 2, Peterson discloses the method wherein the step of capturing comprises the steps of:

receiving claim identification information from a claimant, said claim identification information comprising, at least, one line level (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

storing the line item level data in the insurance host server (See Peterson, Col.7, lines 5-42);

providing a client with an item tree of line item level data based on the line level and aggregating line item level data collected from the claimant (See Peterson, Col.11, lines 34-52);

(C) As per claim 3, Peterson discloses the method wherein the step of evaluating the line item data comprises the steps of

displaying at least one line item from the insurance host server (See Peterson, Col.13, lines 61-67 to Col.14, line 25);

receiving a selection of at least one line item from a claim handler (See Peterson, Col.13, lines 1-13); and

receiving authorization from the claim handler to execute payment of the selected line item, wherein said authorization is for a payment in a form comprising a direct payment, vendor transfer, line item payment, or preauthorized payment (See Peterson, Col.14, lines 46-67).

(D) As per claim 4, Peterson discloses the method comprising steps performed by a data processing system, of: capturing at least one line item data in an insurance host server (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

evaluating the line item data during the processing of an insurance claim (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

enabling the selection of a payment type (See Peterson, Col.10, lines 7-16);
wherein the step of fulfilling comprises the steps of: maintaining a vendor database on
the insurance host server (See Peterson, Col.7, lines 5-42);

placing at least one order for at least one line item from the insurance host server
to a vendor (See Peterson, Col.7, lines 5-42); and

tracking the order on the insurance host server (See Peterson, Col.4, lines 66-67
to Col.5, line 21; Col.7, lines 5-43).

Peterson does not explicitly disclose that the method having capture, evaluation
and fulfillment of line item level data, and fulfilling the payment of a line item based on
the evaluation of the line item data.

However, these features are known in the art, as evidenced by Borghesi. In
particular, Borghesi suggests that the method having capture, evaluation and fulfillment
of line item level data (See Borghesi, Fig.6; Col.2, lines 50-67 to Col.3, line 4); and
fulfilling the payment of a line item based on the evaluation of the line item data (See
Borghesi, Col.5, lines 6-25).

It would have been obvious to one of ordinary skill in the art at the time of the
invention to have included the feature of Borghedsi within the system of Peterson with
the motivation of providing a comprehensive system and method of managing an
insurance claim work flow wherein all the tasks of processing a claim may be performed
and evaluated (See Borghesi, Col.2, lines 20-23).

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(E) As per claim 5, Borghesi discloses the method wherein the step of maintaining a vendor database further comprises the step of entering vendor information in the vendor database (See Borghesi, Fig.8A-8L; Col.10, lines 57-67).

The motivation for combining the respective teachings of Peterson and Borghesi are as discussed in the rejection of claim 4 above, and incorporated herein.

(F) As per claim 6, Borghesi discloses the method wherein the step of maintaining a vendor database further comprises the step of editing vendor information in the vendor database (See Borghesi, Col.12, lines 37-58).

The motivation for combining the respective teachings of Peterson and Borghesi are as discussed in the rejection of claim 4 above, and incorporated herein.

(G) As per claim 7, Borghesi discloses the method wherein the step of maintaining a vendor database further comprises the step of upgrading a vendor to a preferred vendor in the vendor database (See Borghesi, Col.14, lines 29-45).

The motivation for combining the respective teachings of Peterson and Borghesi are as discussed in the rejection of claim 4 above, and incorporated herein.

(H) As per claim 8, Borghesi discloses the method wherein the step of placing at least one order further comprises the step of faxing an order to a vendor (See Borghesi, Col.13, lines 41-67).

The motivation for combining the respective teachings of Peterson and Borghesi are as discussed in the rejection of claim 4 above, and incorporated herein.

(I) As per claim 9, Peterson discloses the method wherein the step of placing at least one order further comprises the step of emailing an order to a vendor (See Peterson Col.9, lines 30-60).

(J) As per claim 10, Peterson discloses the method wherein the step of placing at least one order further comprises the step of placing an order on a web server for vendor access (See Peterson, Col.14, lines 8-45).

The motivation for combining the respective teachings of Peterson and Borghesi are as discussed in the rejection of claim 4 above, and incorporated herein.

(K) As per claim 11, Borghesi discloses the method wherein the step of placing at least one order further comprises the step of placing an order with a vendor by electronic data interchange (See Borghesi, Col.19, lines 11-47).

The motivation for combining the respective teachings of Peterson and Borghesi are as discussed in the rejection of claim 4 above, and incorporated herein.

(L) As per claim 15, Peterson discloses a system for capturing line item data comprising: a processor for executing programs (See Peterson, Col.8, lines 26-47); a memory for storing a program executable by the processor, the stored program

including instructions for (i) capturing at least one line item data in an insurance host server (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

evaluating the line item data during the processing of an insurance claim (See Peterson, Abstract, Col.1, lines 7-15);

wherein fulfilling includes (1) maintaining a vendor database on the insurance host server (See Peterson, Col.7, lines 5-42);

(2) placing at least one order for at least one line item from the insurance host server to a vendor (See Peterson, Col.7, lines 5-42); and (3) tracking the order on the insurance host server (See Peterson, Col.4, lines 66-67 to Col.5, line 21; Col.7, lines 5-43).

Peterson does not explicitly disclose fulfilling the payment of a line item based on the evaluation of the line item data; and a user interface for enabling the selection of a payment type associated with said at least one line item.

However, these features are known in the art, as evidenced by Borghesi. In particular, Borghesi suggests fulfilling the payment of a line item based on the evaluation of the line item data (See Borghesi, Fig.6; Col.2, lines 50-67 to Col.3, line 4); and a user interface for enabling the selection of a payment type associated with said at least one line item (See Borghesi, Col.5, lines 6-25; Col.15, lines 147-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghedsi within the system of Peterson with the motivation of providing a comprehensive system and method of managing an

insurance claim work flow wherein all the tasks of processing a claim may be performed and evaluated (See Borghesi, Col.2, lines 20-23).

(M) As per claim 26, Peterson discloses a computer readable medium containing instructions for controlling a computer system to perform a method for capturing at least one line item data in an insurance host server (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

evaluating the line item data during the processing of an insurance claim (See Peterson, Col.3, lines 65-67 to Col.4, line 20);

enabling the selection of a payment type (See Peterson, Col.7, lines 5-42); and wherein the step of fulfilling comprises the steps of:

maintaining a vendor database on the insurance host server (See Peterson, Col.7, lines 5-42);

placing at least one order for at least one line item for the insurance host server to a vendor (See Peterson, Col.7, lines 5-42); and

tracking the order on the insurance host server See Peterson, Col.4, lines 66-67 to Col.5, line 21; Col.7, lines 5-43).

Peterson does not explicitly disclose that the computer readable medium having capturing, evaluating, and fulfilling line item data (See Borghesi, Fig.6; Col.2, lines 50-67 to Col.3, line 4), fulfilling the payment of a line item based on the evaluation of the line item data (See Borghesi, Col.5, lines 6-25; Col.15, lines 147-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Borghedsi within the system of Peterson with the motivation of providing a comprehensive system and method of managing an insurance claim work flow wherein all the tasks of processing a claim may be performed and evaluated (See Borghesi, Col.2, lines 20-23).

(N) Claims 13-14, 16-22, 24-25 and 27-33 recite the underlying process steps of the elements of claims 2-3 and 5-11, respectively. As the various elements of claims 2-3 and 5-11 and have been shown to be either disclosed by or obvious in view of the collective teachings of Peterson and Borghesi, it is apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 13-14, 16-22, 24-25 and 27-33 are rejected for the same reasons given above for claims 2-3 and 5-11, and incorporated herein.

Response to Arguments

7. Applicant's arguments filed on with respect to claims 2-11, 13-22 and 24-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches system and method for

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managing insurance claim processing (5,950,169) and system and method for supporting delivery of healthcare (6,012,035).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zeender Ryan Florian can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Vanel Frenel

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